

Remarks

Applicants hereby add new claims 35-50 and cancel claims 16-21 and 22-25. Accordingly, claims 1-9 and 35-50 are pending in the present application.

New claims 35-40 and 46-50 correspond to respective claims 10-15 and 22-26 which were originally filed with the application. Applicants respectfully request reconsideration of the rejections of original independent claims 10 and 22 (now claims 35 and 46, respectively) as well as the amended claim 1 and the respective dependent claims of all independent claims in view of the following remarks.

New claims 41-45 are newly presented and are supported at least at paragraphs 19, 30 and 41 of the originally-filed specification.

Claims 1-15 and 22-25 stand rejected under 35 USC 103(a) for obviousness over U.S. Patent No. 6,490,627 to Kalra et al. in view of U.S. Patent No. 5,928,330 to Goetz et al. in further view of U.S. Patent Publication No. 2004/0070786 A1 to Molteno.

Applicants respectfully request reconsideration of the rejections.

Referring to the prior art rejection of new claim 35 (which corresponds to previous independent claim 10), the Office relies upon the teachings of Karla, Goetz and Molteno in support of the 103 rejection. The Office previously relied upon the teachings of Karla and Molteno in support of the rejection of original claim 10 in the Office Action mailed July 11, 2007 in this application (hereinafter the "original Office Action") and subsequently relied upon the teachings of Goetz in response to amendments by Applicants. The amended limitations for which Goetz was presented by the Office have been deleted from new claim 35. Applicants respectfully submit that the 103 rejection of claim 35 over the combination of Karla and Molteno or Karla, Goetz and Molteno is improper and Applicants respectfully request reconsideration and withdrawal of the 103 rejection.

Referring to the 103 rejection of all claims over Karla and Molteno, Applicants respectfully submit that the teachings of Karla have been improperly modified by the teachings of Molteno by the Office in support of the conclusion that the claimed limitations are obvious. More specifically, the MPEP states that the concept of *prima facie* obviousness allocates who has the burden of going forward with production of evidence in each step of the examination process and the

examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. MPEP §2142 (8th ed., rev. 7). As discussed in *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984), the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability. *Some articulated reasoning with some rational underpinning* to support the legal conclusion of obviousness is needed. *KSR Int'l v. Teleflex, Inc.*, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007). MPEP 2142 (8th ed., rev. 7) further provides that rejections on obviousness *cannot be sustained with mere conclusory statements*; instead there must be some articulated reasoning with some rational underpinning to support a legal conclusion of obviousness and which must be *factually supported* per MPEP 2142.

In both the original Office Action and the current Office Action, the Office states that the modification of Karla using Molteno is appropriate in order to improve performance of communication of media based on the preferences of the users or communication link. Applicants respectfully submit this reasoning is not properly supported and the 103 rejection is in error.

In particular, Karla already discloses at col. 2, lines 33+ that the client computers have different configurations and capabilities and also have associated profiles and different amounts of the data may be accessed by the client computers according to the respective profiles of the client computers. The streams accessed from the server are tailored to match the profiles of the client computers so that the best combination of streams can be provided to the clients. Karla further provides that the accessing of different amounts of data allows the various combinations of content and resolution to be tailored to match the capabilities of the client computers.

The Office has provided no support for the allegation that the modification of Karla according to Molteno would improve performance. Karla already provides different amounts of data to different users based upon the profiles of the respective clients and the Office has failed to provide any teachings or any other evidence that the modification to Karla provides any improvement of performance as alleged in support of the rejection.

Applicants respectfully submit there is no rational underpinning in support of the reasoning for the modification of Karla according to Molteno and the 103

rejection is improper for at least this reason.

Applicants respectfully request reconsideration and withdrawal of the 103 rejection. In particular, Applicants respectfully submit all claims are in condition for allowance since all claims stand rejected over the modification of Karla per Molteno.

Referring to the prior art rejection of new claim 46 (which corresponds to previous independent claim 22), the Office relies upon the teachings of Karla, Goetz and Molteno in support of the 103 rejection. The Office previously relied upon the teachings of Karla and Molteno in support of the rejection of original claim 22 in the original Office Action and subsequently relied upon the teachings of Goetz in response to amendments by Applicants. The amended limitations for which Goetz was presented by the Office have been deleted from new claim 46. Applicants respectfully submit that the 103 rejection of claim 46 over the combination of Karla and Molteno or Karla, Goetz and Molteno is improper for the above-mentioned reasons and Applicants respectfully request reconsideration and withdrawal of the 103 rejection of claim 46 in consideration of the improper combination of the reference teachings of Karla and Molteno.

Further referring to independent claim 1, Applicants respectfully submit that positively-recited limitations are not disclosed nor suggested by the numerous prior art references of Karla, Goetz and Molteno even if the references are combined. Applicants respectfully submit that the limitations of claim 1 are not obvious over the prior art of record for at least this reason.

In particular, claim 1 clearly recites *arranging scalable media data into data structures formatted in accordance with a content independent indexable data structure format and retrieving from the bit stream using the format of the content independent indexable data structures respective ones of the requested subparts.*

The Office relies upon the teachings of Goetz as allegedly disclosing the above-recited limitations. Applicants respectfully submit Goetz fails to teach these limitations and the 103 rejection of claim 1 is in error for this additional reason.

In particular, Goetz teaches that the audio or video content contains data packets in the file body at col. 6, lines 35. Col. 8, lines 32 states that each packet includes pre-assigned importance information indicative of the relative importance of the packet with respect to the quality of the presentation and some packets are highly important where the data would be unintelligible in their absence or less

important and concealable. Goetz provides in the Abstract that the server streams the units of multimedia to the client in response to the importance information (which is content dependent of whether the content of the data packet is important or concealable).

Applicants respectfully submit that the explicit teachings of Goetz of streaming packets in response to the importance of the data content fails to teach or suggest the above-recited limitations of arranging and retrieving in accordance with or using the content independent indexable data structure format as claimed.

Applicants respectfully submit that the above-recited limitations of claim 1 are not disclosed nor suggested by the prior art even if the references are combined and the 103 rejection is in error for at least this reason.

In addition, Applicants refer to MPEP 2141.02VI (8th ed., rev. 7) entitled **PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS.** This MPEP section further states that a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983). Such teaching away is the antithesis of the art's suggesting that the person of ordinary skill go in the claimed direction. Essentially, teaching away from the art is a *per se* demonstration of lack of obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

The explicit teaching in Goetz of streaming data according to the content dependent importance information teaches away from the arranging and retrieving limitations recited in claim 1 and claim 1 is allowable for at least this additional reason.

The pending dependent claims are in condition for allowance for the reasons discussed above with respect to the respective independent claims from which they depend as well as for their own respective features which are neither shown nor suggested by the cited art.

Applicants respectfully request allowance of all pending claims.

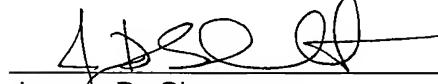
The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours

Serial No. 10/699,444
HP Case No. 10017341-1
Amendment A

(Pacific Time Zone).

Respectfully submitted,
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